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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,937	12/31/2003	Darren R. Sherman	212/546	1907

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EXAMINER

DEMILLE, DANTON D

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,937

Applicant(s)

SHERMAN ET AL.

Examiner

Danton DeMille

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/31/3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 2 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 5 of copending Application No. 10/464818. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of copending Application No.

10/464,818. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to leave out the details of the second spindle.

5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. **Claims 3-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5, 16 and 17 of copending**

Application No. 10/464818. Although the conflicting claims are not identical, they are not patentably distinct from each other because the location of the first and second spindles under the patient scapula they would inherently be approximately 12 to 20 inches apart. Regarding claim 7, the left and right axilla are approximately in the same location as the left and right scapula. It would be difficult to distinguish the two locations. Moreover, since the distance between the left and right axilla and left and right scapula are the same they would comprehend structurally the same distance.

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. **Claims 8-16 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 16 of copending Application No.**

10/464818. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to leave out the details of the location of the spindles from claim 8. Regarding claim 9, since the prior application claims that the first and second spindles are located under the patient scapula they would inherently be approximately 12

to 20 inches apart. Regarding claims 14-16, the left and right axilla are approximately in the same location as the left and right scapula. It would be difficult to distinguish the two locations. Moreover, since the distance between the left and right axilla and left and right scapula are the same they would comprehend structurally the same distance.

9. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. **Claims 17-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-17 of copending Application No. 10/464818.** Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to perform the method of using the device claimed in the previous application.

11. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. **Claims 21-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5, 16 and 17 of copending Application No. 10/464818.** Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to perform the method of using the device recited in the previous claims.

13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. **Claims 1, 8, 10-12, 17, 19-20 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 22 of copending**

Application No. 09/954544 in view of Mollenauer WO 99/09929. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to include a platform as taught by Mollenauer on which to support the device and patient. It also would have been obvious to provide the method of performing chest compressions on a patient by providing the previously claimed device and performing steps inherent in the function of the device. It also would have been obvious to one of ordinary skill in the art to include the drive spool and spindle assembly 7 of Mollenauer to provide the details of the drive mechanism.

15. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. **Claims 1, 2, 4, 5, 6, 8, 10, 11, 12, 17, 19, 20, 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-31 of U.S. Patent No. 6,939,314 in view of Mollenauer WO 99/09929.** Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to include a platform, motor, drive spool and spindles as taught by Mollenauer to provide the details of the means to repetitively tighten the belt. Regarding the method claims, it would have been obvious to provide the steps inherent in the use of the device.

Claim Rejections - 35 USC § 103

1. **Claim 1, 19, 20, 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Mollenauer WO 99/09929 in view of Meister and Bastyr et al. '622.**

2. Meister teaches a belt adapted to extend around the chest of the patient including compression pads 3. Meister appears silent with regard to the exact composition of the pads 3.

Such details are well within the realm of the artisan of ordinary skill. The pads would appear to be envelopes filled with foam. Such is one example of a conventional pad. An air filled bladder is another obvious equivalent conventional pad. Bastyr teaches the convention of using an air filled bladder 40, 42, 44, 46, 48, 50. It would have been obvious to one of ordinary skill in the art to modify Mollenauer to include pads as taught by Meister to help cushion the compression forces being applied to the patient and to use an air bladder as taught by Bastyr to provide the details of the construction of a pad.

3. Regarding claim 19, it would have been obvious to perform the method of using this device by providing the device operably connecting the device to the patient and compressing the chest of the patient. Such would be inherent steps in using the device.

4. **Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over either Mollenauer WO 99/09929 or Sherman et al. '106.**

5. It would have been obvious to one of ordinary skill in the art to modify either Mollenauer or Sherman to perform the method of using these device that would inherently include providing the device operably connecting the device to a patient and compressing the chest of the patient.

Claim Rejections - 35 USC § 102

6. **Claims 8, 10, 11, 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mollenauer WO 99/09929.**

7. Mollenauer teaches everything claimed including the multiple spindles 7. Regarding claim 12, the center spindle would be placed under the spine and the other two spindles would be placed on opposite sides of the spine.

8. **Claims 8, 9, 10, 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sherman et al. '106.**

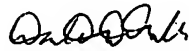
9. Sherman teaches everything claimed including the multiple spindles 15 and 29. Spindle 29 is also located near the scapula and axilla of the patient and therefore spaced apart approximately within the range of about 12 to 20 inches.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danton DeMille whose telephone number is (571) 272-4974. The examiner can normally be reached on M-Th from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson, can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3 February 2006


Danton DeMille
Primary Examiner
Art Unit 3764